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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/660,820

09/12/2003

Huy D. Phan

03-140 (US01)

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EXAMINER

VRETTAKOS, PETER J

ART UNIT

PAPER NUMBER

3739

MAIL DATE

DELIVERY MODE

06/08/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/660,820

Applicant(s)

PHAN ET AL.

Examiner

Peter J. Vrettakos

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13, 14 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-14 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

This instant action is non-final and withdraws finality. The Applicant argued by telephone 5-30-07 that Whitebrook (6,529,775) did not anticipate Applicant's claimed invention because in the 35 USC § 102 rejection the Examiner drew elements from several different embodiments in Whitebrook (instead of just one embodiment) and thus the exemplary assembled embodiment in the rejection was allegedly not enabling and thus improper. Without conceding to these points, the Office has changed the anticipation rejection to one of obviousness.

Claims 1-11, 13-14 and 18 are elected. Claim 1 is independent.

The Applicant's claimed invention is best depicted in figures 20-23.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11, 13-14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitebrook et al. (6,529,775).

Whitebrook discloses a catheter with a proximal handle (108/104) with steering mechanism (to permit collapsing of distal end), electrodes (412), a collapsible (figure 4d) circumscribed cage assembly/protective element (see figures 4c-4i) with plastic (col.

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9:49) struts (432-434) proximally fixedly secure (448), a distal (see figure 4i) slidable (441,449) coaxial ring element (447), a sleeve (437) all for use to emit energy in a blood vessel while avoiding emitter contact with the blood vessel or bodily cavity (col. 8:46-50).

The rejection includes elements drawn from several different embodiments in Whitebrook. The patent invites this sort of modification of embodiments in col. 15:65 through col. 16:2. The Office assert that Whitebrook makes obvious modifications to its embodiments resulting in the Applicant's claimed invention.

Claim 6 is merely a reversal of parts in Whitebrook, and claims 16 and 17 are duplication of parts in Whitebrook. MPEP § 2144.04 reads:

VI. REVERSAL, DUPLICATION, OR REARRANGEMENT OF PARTS

A. Reversal of Parts

In re Gazda, 219 F.2d 449, 104 USPQ 400 (CCPA 1955) (Prior art disclosed a clock fixed to the stationary steering wheel column of an automobile while the gear for winding the clock moves with steering wheel; mere reversal of such movement, so the clock moves with wheel, was held to be an obvious expedient.).

B. Duplication of Parts

In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) (Claims at issue were directed to a water-tight masonry structure wherein a water seal of flexible material fills the joints which form between adjacent pours of concrete. The claimed water seal has a "web" which lies ** in the joint, and a plurality of "ribs" ** >projecting outwardly from each side of the web into one of the adjacent concrete slabs. <The prior art disclosed a flexible water stop for preventing passage of water between masses of concrete in the shape of a plus sign (+). Although the reference did not disclose a plurality of ribs, the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.).

Claim 11 is an obvious design choice (braided/woven protective element) in light of Whitebrook's struts/spacers (413). Further, the Applicant provides no criticality or unexpected results for choosing a braided or woven protective element instead of the

strut/spacer cage assembly. Even further, the intertwined design of the spacers 432-434 in figures 4h-I are also arguably "woven".

Response to Arguments

Applicant's arguments filed 9-27-06 have been fully considered but they are not persuasive. Whitebrook discloses RF electrodes 402 (which are very commonly used for ablation) without expressly disclosing "ablation". In conjunction with the fact that there is no "verbatim standard" applied to patent law rejections this "deficiency" in Whitebrook is irrelevant for at least two reasons. One, disclosure of an RF electrode is tantamount to disclosing an ablation electrode (and hence "system") due to the ubiquity of RF electrodes used for ablation in the electrosurgical arts. Two, disclosure of an RF electrode is disclosure of a structure **capable** of ablation. The Office does maintain a "**capable** standard" which reads, "a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is **capable** of performing the intended use, then it meets the claim." Here, the intended use is ablation and Whitebrook RF electrode is certainly capable of ablation, notwithstanding Whitebrook's lack of express disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pete Vrettakos
May 31, 2007




ROY D. GIBSON
PRIMARY EXAMINER